The opinion in support of the decision being entered today
is not binding precedent of the Board.

Paper No. 54
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

ANDREW S. KATOCS, JR., ELWOOD LARGIS AND SOTIRIOS K. KARATHANAS

Junior Party[1],

v.

RONALD M. EVANS, DAVID J. MANGELSDORF, RICHARD A. HEYMAN,
MARCUS F. BOEHM, GREGOR EICHELE AND CHRISTINA THALER

Senior Party[2]

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Patent Interference No. 103,931

SUPPLEMENTAL DECISION
ON
JOINT SUPPLEMENTAL PRELIMINARY MOTION UNDER 37 CFR §1.633(C)

Lorin, Administrative Patent Judge

[1] Application 07/860,814, filed March 31, 1992, now US 5,219,888. Assignors to American Cyanamid Company.

[2] Application 08/482,737, filed June 7, 1995. Accorded the benefit of application 08/244,857, filed June 14, 1994, 08/809,980, filed December 18, 1991, now abandoned, and PCT US92/11214, filed December 18, 1992. Assignors to The Salk Institute for Biological Studies, Baylor College of Medicine, and Ligand Pharmaceuticals, Inc.

The parties recently received the following papers:

- "DECISION ON JOINT SUPPLEMENTAL PRELIMINARY MOTION UNDER 37 CFR §1.633(C)" (Paper No. 52, mailed August 20, 2002) [August 20 Decision];

and,

- "REDECLARATION OF INTERFERENCE" (Paper No. 53, mailed August 20, 2002) [August 20 Redeclaration].

As a result of the August 20 Decision/Redeclaration, the interference is presently defined as follows:

Count A

A method to modulate lipid metabolism in a subject, said method comprising administering to said subject an effective amount of all trans-retinoic acid, or pharmaceutically acceptable carrier containing same;

or

A method of increasing plasma HDL levels in a mammal which comprises administering all trans-retinoic acid in a pharmacologic amount effective to increase said plasma HDL levels.

The claims of the parties which correspond to Count A are:

Katocs et al. (U.S. Patent No. 5,219,888):	Claim 1
Katocs et al. (Reissue Application 09/176,003):	Claim 1
Evans et al. (Application 08/482,737):	None

Count B

A method to modulate lipid metabolism in a subject, said method comprising administering to said subject an effective amount of 9-cis-retinoic acid, or pharmaceutically acceptable carrier containing same;

or

A method of increasing plasma HDL levels in a mammal which comprises administering 9-cis-retinoic acid in a pharmacologic amount effective to increase said plasma HDL levels.

The claims of the parties which correspond to Count B are:

Katocs et al. (U.S. Patent No. 5,219,888):	Claim 1
Katocs et al. (Reissue Application 09/176,003):	None
Evans et al. (Application 08/482,737):	Claim 30

It has come to undersigned's attention that Evans has no claim designated to correspond to Count A. This is improper.

It is axiomatic that an interference is a proceeding between two or more parties claiming the same patentable invention and exists when at least one claim of a party and at least one claim of an opponent are designated to correspond to a count and the count defines the same patentable invention. See 37 C.F.R. § 1.601(i) and (j). The requirement that both parties have claims designated to correspond to a count is met with respect to Count B. It is not met with respect to Count A. Senior Party Evans does not have a claim designated to correspond to Count A. Consequently, Count A does not define interfering subject matter and, therefore, cannot be a proper count.

Undersigned is mindful that the parties have made every effort to advance this interference to termination and that "in contemplation of the termination of the above captioned interference" (Paper No. 30, p. 2), the parties have filed an executed settlement agreement with the Board pursuant to 35 USC § 135(c) and 37 CFR § 1.666 (Paper No. 36) and concessions of priority by which Evans concedes priority to Katocs under 37 CFR § 1.662(a) of the subject matter of Count A directed to administering an effective amount of all-trans-retinoic acid to either modulate lipid metabolism in a subject or increase plasma HDL levels in a mammal (Paper No. 39), and Katocs concedes priority to Evans under 37 CFR § 1.662(a) of the subject matter of Count B directed to administering an effective amount of 9-cis-retinoic acid to either modulate lipid metabolism in a subject or increase plasma HDL levels in a mammal (Paper No. 40).

To that end, undersigned takes the following actions modifying the August 20 Decision.

Parties will recall that the August 20 Decision granted the following motions

1. "Katocs Preliminary Motion to Substitute a Different Application Pursuant to 37 CFR § 1.633(h)" (Paper No. 51);

2. "Katocs Preliminary Motion for Benefit of the Filing Date of an Earlier Filed Application Pursuant to 37 CFR §1.633(f)" (Paper No. 50);

3. "Joint Supplemental Preliminary Motion Pursuant to 37 CFR § 1.633(c)" (Paper No. 48); and,

4. "Preliminary Motion to Redefine the Interference Pursuant to 37 C.F.R. 1.633(c)" (Paper No. 38).

Undersigned withdraws the rulings with respect to these four motions and rules instead as follows:

1. "Katocs Preliminary Motion to Substitute a Different Application Pursuant to 37 CFR § 1.633(h)" (Paper No. 51) is DENIED;

2. "Katocs Preliminary Motion for Benefit of the Filing Date of an Earlier Filed Application Pursuant to 37 CFR §1.633(f)" (Paper No. 50) is DENIED;

3. "Joint Supplemental Preliminary Motion Pursuant to 37 CFR § 1.633(c)" (Paper No. 48) is GRANTED-IN-PART; and,

4. "Preliminary Motion to Redefine the Interference Pursuant to 37 C.F.R. 1.633(c)" (Paper No. 38) GRANTED-IN-PART.

"Joint Supplemental Preliminary Motion Pursuant to 37 CFR § 1.633(c)"

The "Joint Supplemental Preliminary Motion Pursuant to 37 CFR § 1.633(c)" (Paper No. 48), like the earlier "Preliminary Motion to Redefine the Interference Pursuant to 37 C.F.R. 1.633(c)" (Paper No. 38), sought to designate

- claim 1 of Katocs' '888 patent, which is directed to using 9-cis-retinoic or all-

trans-retinoic acid, to correspond to both proposed Counts A and B;

- claim 30 of Evans' '737 application, which is directed only to using 9-cis-retinoic acid, to correspond to Count B; and,
- claim 1 of Katocs' '003 reissue application, which is directed only to using all-trans-retinoic acid, to correspond to Count A.

Given that the parties had not moved to designate any Evans claim to correspond to proposed Count A and thereby failed to provide a basis for defining an interference for the subject matter of proposed Count A, that part of the "Joint Supplemental Preliminary Motion Pursuant to 37 CFR § 1.633(c)" (Paper No. 48) and earlier Preliminary Motion to Redefine the Interference Pursuant to 37 C.F.R. 1.633(c)" (Paper No. 38) which sought to add proposed Count A to the interference and to designate claim 1 of Katocs patent and claim 1 of Katocs reissue application to correspond to proposed Count A should have been denied. Accordingly, undersigned withdraws that decision and denies instead the motion giving the parties leave to add Count A to the interference and to designate claim 1 of Katocs patent and claim 1 of Katocs reissue application to correspond to proposed Count A. Undersigned maintains the earlier decision to grant parties leave to substitute Count B for the earlier Count and to designate claim 1 of Katocs' '888 patent and claim 30 of Evans' '737 application to correspond to Count B. The motion is GRANTED-IN-PART.

"Preliminary Motion to Redefine the Interference Pursuant to 37 C.F.R. 1.633(c)"

The parties will recall that they filed an earlier "Preliminary Motion to Redefine the Interference Pursuant to 37 C.F.R. 1.633(c)" (Paper No. 38) and that undersigned denied that motion on two grounds.

First, the parties sought to designate claim 1 of Katocs reissue application 09/176,03 to correspond to proposed Count A and yet no motion under 37 CFR §1.633(h) had been filed to add the reissue application to this interference. Undersigned was not in a position to consider whether to designate Katocs reissue claim 1 to correspond to a count, given that Katocs reissue application 09/176,003 was not a part of the interference. To rectify the situation, Katocs subsequently filed motions under 37 CFR §§1.633(h) (see "Katocs Preliminary Motion to Substitute a Different Application Pursuant to 37 CFR § 1.633(h)" (Paper No. 51)) and (f) (see "Katocs Preliminary Motion for Benefit of the Filing Date of an Earlier Filed Application Pursuant to 37 CFR §1.633(f)" (Paper No. 50)) and these were granted in the August 20 Decision. In retrospect, these motions should have been denied. Accordingly, that portion of the "Preliminary Motion to Redefine the Interference Pursuant to 37 C.F.R. 1.633(c)" relying on the subsequently filed motions is hereby withdrawn and denied instead.

The second grounds for denying the earlier "Preliminary Motion to Redefine the Interference Pursuant to 37 C.F.R. 1.633(c)" (Paper No. 38) was that undersigned was not satisfied that the parties had met their burden under 37 CFR § 1.633(c) to "[s]how that each proposed count defines a separate patentable invention from every other

count proposed to remain in the interference" (37 CFR § 1.637(c)(1)(v)), in accordance with the test set forth in 37 CFR 1.601(n). However, as stated in the August 20 Decision, the parties' subsequent response ("Joint Supplemental Preliminary Motion Pursuant to 37 CFR § 1.633(c)" (Paper No. 48)) did satisfy undersigned's concerns in showing that the use of 9-cis retinoic acid and all-trans retinoic acid define separate patentable inventions. That finding remains unchanged. Consequently, that part of the August 20 Decision is not modified. Accordingly, undersigned affirms the "Preliminary Motion to Redefine the Interference Pursuant to 37 C.F.R. 1.633(c)" to the extent that it seeks to substitute Count B for the original Count and, thereby, consistent with the finding that the use of 9-cis retinoic acid and all-trans retinoic acid define separate patentable inventions, the subject matter directed to the use of 9-cis retinoic acid (Count B) is separated from the generic subject matter covering both 9-cis-retinoic acid and all-trans retinoic acid (original Count). Accordingly, the motion is GRANTED-IN-PART.

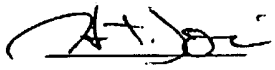
"Katocs Preliminary Motion to Substitute a Different Application Pursuant to 37 CFR § 1.633(h)" AND "Katocs Preliminary Motion for Benefit of the Filing Date of an Earlier Filed Application Pursuant to 37 CFR §1.633(f)"

The ultimate goal of filing the §§1.633(f) and (h) motions was to have claim 1 of Katocs' reissue application designated to correspond to proposed Count A. However, as explained earlier, there has been no corresponding motion to have any Evans claim designated to correspond to proposed Count A. Accordingly, proposed Count A was an improper count and the designation of claim 1 of Katocs' Patent and claim 1 of Katocs' reissue application as corresponding to proposed Count A should not have been

granted. Accordingly, "Katocs Preliminary Motion to Substitute a Different Application Pursuant to 37 CFR § 1.633(h)" (Paper No. 51)) and the corresponding "Katocs Preliminary Motion for Benefit of the Filing Date of an Earlier Filed Application Pursuant to 37 CFR §1.633(f)" (Paper No. 50), the August 20 Decision granting those motions is hereby withdrawn and the motions are DENIED instead.

SUMMARY

The earlier August 20 Decision is superceded by this Decision. This Decision changes the earlier rulings with respect to the four motions filed in this interference. The result is that there is no longer a count specifically directed to using all-trans retinoic acid. This also means that claim 1 of the Katocs Reissue Application is no longer designated to correspond to any count in this interference and, it follows therefrom, that the Katocs' Reissue application 09/176,003 in no longer a part of this interference. The interference is being redeclared consistent with this new Supplemental Decision. Concurrently therewith, a Judgment is entered consistent with the parties concession of priority.



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